Immunocept, LLC, et al v. Fulbright & Jaworski Doc. 8

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

FILED

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WESTERN DISTRICT OF TEXAS
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IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
vs.	§	**CAUSE NO. A 05 CA 334 SS**
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

PLAINTIFFS' REPLY BRIEF IN SUPPORT OF MOTION FOR THE LEGAL INTERPRETATION OF CERTAIN CLAIM LANGUAGE

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I. INTRODUCTION

Two facts are inescapable in this lawsuit: (1) the scope of the claims of Immunocept's patent is squarely at the heart of the dispute, and (2) determining the scope of patent claims is a matter of law reserved to the Court. These two facts compel a *Markman* analysis of the patent claims. Immunocept brought this motion to assist the Court in that analysis, and to indicate what the proper claim construction should be.

Fulbright does not offer the Court any alternative construction of the claims. Instead, Fulbright denies reality through the astonishing assertion that there is no case or controversy here. As Fulbright would have it, there can be no justiciable issue of claim construction unless and until some third party is sued for infringement. The absurdity of that notion is readily apparent. In Fulbright's world, a malpractice blunder that so narrows the claims as to make infringement virtually impossible, and thus precludes any good faith infringement suit ever being brought, would go forever unanalyzed; courts would be powerless ever to determine what patent coverage had been lost, and incompetent attorneys would never be held accountable for their malfeasance.

Fulbright's real aim here is to circumvent the mandated *Markman* process, and place a fundamentally legal issue before the jury, in the hope that the jury will prefer Fulbright's expert to Immunocept's. Fulbright's expert, John Kirk, has argued that Immunocept has suffered no significant damage because the scope of the patent remains substantially intact, thus squarely framing the controversy that Fulbright would have the Court overlook. No law supports putting that matter before the jury, because the Federal Circuit has plainly decreed it to be the sole province of the Court.

The best that Fulbright can muster is a collection of *declaratory judgment* cases, where absence of a true infringement issue meant that a competitor had no basis to seek a ruling on the scope of the defendant's patent. Here, the scope of Immunocept's own patent has been in controversy since Day One, as described in Paragraph 17 of the Complaint. Fulbright has not moved for dismissal of the action for failure to state a claim or for lack of a controversy. The issue now before the Court is real, central to the case, and ripe for determination.

II. FACTUAL BACKGROUND

Despite Fulbright's protests, there can be no doubt that Fulbright and its expert John Kirk both know that claim construction is a central issue in this case, as shown by Kirk's testimony.

> I think that anything that was described in terms of a support system for the patient would not -- used in conjunction with the hemofiltration, assuming the hemofiltration is exactly as claimed in the patent, wouldn't be -- would not avoid infringement. (Kirk Dep. 113:5-11 attached as Exh. A).

Using his interpretation of claim 1, Kirk concludes that Large Pore Hemofiltration together with the following additional steps still fall within the scope of the '418 patent: (1) "minor or peripheral additions to the filter such as controls, gauges, valves . . .." (Kirk Report at ¶14 attached as Exh. B); (2) adding a drug to inhibit infection like antibiotics (Kirk Dep. at 115:12-23); (3) adding a drug to inhibit toxic mediators (Kirk Dep. at 115:24-116:1).

Similarly, Kirk also interprets claim 1's preamble "treating a pathophysiological state caused by a toxic mediator-related disease . . . . *would not be considered to be a claim limitation*." *Id.* at 9 (emphasis added). Kirk further concludes that it is "doubtful" that Fulbright could have used the preamble to distinguish the prior art. *Id.*

Of course Immunocept's expert, Alan MacPherson, relies on his own different claim interpretation to support his opinions. (MacPherson Report at ¶ 21 attached as Exh. C).

However, the issue of claim interpretation cannot and should not be decided by an expert swearing contest. This Court must instruct the jury on the proper interpretation of the claims.

III LEGAL ANALYSIS

A. Claim Interpretation Is Purely a Legal Issue.

If anything is settled in patent law, it is that claim interpretation is a legal issue for the Court. In *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996), the Federal Circuit held:

> We therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and the *obligation to construe as a matter of law* the meaning of language used in the patent claim. *Id.* at 979 (emphasis added).

This obligation may not be avoided, even if the parties ardently wish it. In *Cytologix Corp. v. Ventana Medical Systems, Inc*, 424 F.3d 1168, 1172 (Fed. Cir. 2005), the parties agreed to allow their experts to rely on their own differing claim construction. The Federal Circuit rejected this practice as "improper" because of the risk of jury confusion. *Id.* Similarly, this Court should avoid jury confusion and construe the claims before the experts provide testimony that relies on different premises.

Finally, Fulbright's assertion that "[a] Markman analysis has no place in a case based solely on negligence" (Fulbright Response at p. 3) is wrong on both the facts and the law. Factually, Fulbright's expert undermines this argument because Kirk's conclusions rely on his own interpretation of the claims. Legally, the decisions Fulbright rely upon are far afield from this case. Fulbright cites to *Vivid Technologies Inc. v. America Science & Eng, Inc.* 200 F.3d 795, 806 (Fed. Cir. 1999) for the unremarkable proposition that a patentee bears the burden of proving infringement. Of course that is true in an infringement case, not in a malpractice case where the relevant issue is how drastically the defendant shrank the scope of the patent. Fulbright also relies on a convenient sound bite from *Level Ones Communs. v. Seeq Tech.* 987 F.Supp. 1191, 1204 (N. D. Cal. 1997) -"it is not the purpose of a

Markman hearing to seek to strategically limit a patent's claims under the guise of a genuine dispute as to meaning" - to argue that Immunocept's request to have the Court construe claims is "frivolous." However, the court in *Level Ones* was describing a party's strained claim construction, not the request for a *Markman* ruling. Indeed, the court in that case construed the claims at issue, as this Court must here.

B. Immunocept's Claim Construction Is Correct.

Immunocept's moving papers ask the Court to rule that the term, "consisting of" limits claim 1 to a single recited step. In response, Fulbright cites to *Norian v. Stryker Corp.*, 363 F.3d 1321, 1332 (Fed. Cir. 2004) to point out that elements that are "irrelevant to the invention" may be added and still fall within the scope of the claim. Fulbright misses the point again. Immunocept's proposed claim construction addresses additional steps that are *relevant* to the invention. The transition "consisting of" modifies the phrase for "[a] method of treating a pathophysiological state caused by a toxic mediator-related disease" ("Disease") and Immunocept's proposed definition suggests that claim 1 would not cover a method that added steps to treat the Disease. Immunocept's claim construction says nothing about additional steps that are *unrelated* to treating the Disease. For example, if physicians added a step of taking vitamin C to the large pore hemofilter step recited in claim 1, that combination of steps would still fall within the scope of the claim.

Citing *Catalina Marketing, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002), Immunocept asked the Court to rule that claim 1's preamble is limiting because the preamble was used to distinguish the prior art during the prosecution of the '418 patent. In response, Fulbright argues that the statements in *Catalina Marketing* were dicta and not applicable "during the prosecution process." However, the principle announced in *Catalina*

Marketing appears verbatim in the current Manual of Patent Examining Procedure (MPEP) at §2111.02 (attached as Exhibit D). Of course attorneys and examiners use the MPEP "during the prosecution process." The relevant *Catalina Marketing* passage is also quoted verbatim and cited in the subsequent Federal Circuit cases *In Re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1347 (Fed. Cir. 2002), and *Invitrogen v. Biocrest*, 327 F.3d 1364, 1370 (Fed. Cir. 2003). It is good law applicable both in court and in the Patent Office.

Immunocept also asked the court to construe "blood" and "whole blood" to mean blood as drawn from the body. In response, Fulbright points out that that '418 patent also refers to blood that returns to the body and uses the term in the context of arterial or venous hemofiltration. However, all these passages are consistent with Immunocept's definition which serves two purposes: (1) it places the term in the context of claim 1; (2) it differentiates blood from plasma. Moreover, Fulbright offers no alternative definition. Given Fulbright's abdication, the Court should adopt Immunocept's claim construction.

C. There Is Legitimate Case or Controversy.

Finally, Fulbright tries to avoid having the claims construed by arguing that this Court does not have jurisdiction to interpret the claims because there is no article III "case or controversy." The *Laitram* decision that Fulbright relies upon relates to declaratory judgment jurisdiction. Here, Immunocept's complaint describes Fulbright's malpractice and that issue is clearly in controversy.

IV. CONCLUSION

In defense of this malpractice action, Fulbright has relied on an expert unbounded by Federal Circuit precedent and the cannons of claim construction. Immunocept's Motion to Exclude John Kirk, this Claim Construction Motion, and the Motion for Partial Summary

Judgment are all directed to limiting Fulbright' defenses to those that are consistent with established patent law. Accordingly, this Court should construe the claims of the '418 patent and rule on the pending legal issues.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served *via facsimile* on this the 21th day of March 2006:

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